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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,483	12/28/2000	Chio Arjona Alejandro Rafael	MX/JFC- 0018	5891

7590 06/17/2004

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,483

Applicant(s)

RAFAEL ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11, 13-23, and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11, 13-23 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1711

1. The amendment filed April 1, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Support has not been provided for the amended structure of formula I. The structure is not representative of a polymeric structure, and applicants have provided no clear rationale as to how the disclosure provides support for the structure as amended.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The amendment to claim 23 is improper under 37 CFR 1.121, because the claim contains subject matter that is both underlined (denoting addition) and bracketed (denoting deletion).

3. Claims 6-11, 13-23, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Within claim 6, support has not been provided for amended formula I. The structure is not representative of a polymeric structure, and applicants have provided no clear rationale as to how the disclosure provides support for the structure as claimed. Furthermore, support has not been provided for the temperature conditions within claims 13-16 and 20, as the conditions relate to the claimed process step or operation. With respect to claim 13, there is no clear disclosure that a crystallization operation is performed at 50°C. The specification merely

Art Unit: 1711

states that crystallization begins at the recited temperature. Within claim 14, applicants claim that the diisocyanate is stirred at a temperature of 60°C; however, the specification merely states that the temperature is prevented from rising above 60°C. The situation is similar for claim 16. With respect to claim 15, the specification states that the temperature is raised after addition of catalyst, it does not state that the catalyst is added at a temperature up to 180°C. With respect to claim 20, there is no apparent correlation between the disclosed viscosity and the disclosed temperature.

4. Claims 7, 8, 10, 11, 15, 16, 18, 20, 23, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the subject matter of claims 7 and 8 fails to further limit claim 6.

Secondly, within claim 8, “the diamine” lacks antecedence.

Thirdly, within claim 10, it is unclear which “catalyst” of claim 6 is being referred to.

Claim 6 refers to a catalyst within step b) and step h).

Fourthly, it is unclear how the catalyst limitation (“after step h”) of claim 15 relate to the catalyst recitation within step h) of claim 6.

Fifthly, within claim 18, it is unclear what product is being referred to. According to the specification, the product of step j) at page 6 has the claimed viscosity property.

Sixthly, within claim 20, “polyglycolyl” lacks antecedence from claim 6.

Seventhly, within claim 23, “methyl methyl diglycinate” lacks antecedence from claim 6.

Art Unit: 1711

Lastly, it is unclear what process is being set forth by the subject matter of claim 26. The claim fails to set forth any definitive process steps for the production or application of a coating.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent

June 13, 2004


RABON SERGENT
PRIMARY EXAMINER